UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 10

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OFFICE OF PETITIONS

In re Application of   :
Byung Hoon Ahn et al.   :
Application No. 09/845,601   : DECISION REFUSING STATUS
Filed: April 26, 2001   : UNDER 37 CFR 1.47(a)
For: Leadframe and Semiconductor   :
Package Made Using the Leadframe

This is in response to the papers filed August 2, 2001, requesting that the above-identified application be accorded a filing date of April 26, 2001, rather than the presently accorded filing date of April 27, 2001. The request is properly being treated as a petition under 37 CFR 1.10(c). This is also a decision in response to the "Petition Under 37 CFR 1.47(a)," filed August 29, 2001.

The petition under 37 CFR 1.10(c) is <u>granted</u>.

The petition under 37 CFR 1.47(a) is <u>dismissed</u>.

Applicants request the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on April 26, 2001, pursuant to the requirements of 37 CFR 1.10. In support , applicants provide a copy of the receipt for Express Mail label No. EL710212794US, the same Express Mail label number which appears on the original application transmittal letter. In addition, it is noted that the Express mail receipt includes a "San Jose, CA, USPS" receipt stamp date of "April 26, 2001".

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on April 26, 2001.

As to the petition under 37 CFR 1.47(a):

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), Rule 47 applicant failed to show or provide proof that inventors Byung Hoon Ahn and Jae Hun Ku have refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, a complete copy of the application papers (specification, claims and drawings and oath or declaration) must have been presented. While a copy of a letter dated May 25, 2001 has been submitted as evidence in support of the petition, the letter does not give an indication that the complete application was presented to the nonsigning inventors and no additional evidence has been submitted showing that the inventors were presented with a complete copy of the application papers. Did the nonsigning inventors receive a complete copy of the application papers? See Manual of Patent Examining Procedure, Section 409.03(d). Petitioner should show that a complete copy of the application papers was presented to the nonsigning inventors, but that they did not respond to the request to sign the oath or declaration in order to show that the nonsigning inventors have refused to join in the application. A complete copy of the application papers should be sent to the last known addresses of the non-signing inventors or the attorneys representing the nonsigning inventors, return receipt requested, with a request that they sign the declaration for the patent application and setting a deadline with a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and must be supported by documented evidence, such as copies of returned mail receipt showing proof of service, cover letter of instructions, telegraphs, E-mail, etc. See MPEP 409.03(d).

Where there is an express or oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Office of Petitions
                  Assistant Commissioner for Patents
                  Box DAC
                  Washington, D.C. 20231

By FAX: (703) 308-6916
                  Attn: Office of Petitions

By hand: Office of Petitions
                  Crystal Plaza Four, Suite 3C23
                  2201 South Clark Place
                  Arlington, VA 22202

The application file is being retained in the Office of Petitions to await a decision on the petition under 37 CFR 1.47(a), afterwards the file will be forwarded to the Office of Initial Patent Examination for processing with a filing date of April 26, 2001 and for mailing of a corrected Filing Receipt.

Telephone inquiries related to this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond   Brian Hearn
Paralegal Specialist   Senior Petitions Examiner
Office of Petitions   Office of Petitions
Office of the Deputy Commissioner   Office of the Deputy Commissioner
  for Patent Examination Policy   for Patent Examination Policy